Remarks

1. Applicants note that the Examiner has made the Office Action final on the basis that the new ground of rejection set out in the Office Action was necessitated by Applicants' amendment contained in Applicant's previous response. However, Applicants ask the Examiner to note that Applicants had no knowledge of the newly cited reference, Wong (US6073178), and therefore Applicants could not have anticipated its application against the claims. Consequently, Applicants request that the Examiner exercise some discretion in considering the following submission. In any event, the following submission is not considered to raise new issues and therefore provides no grounds for refusing to enter this response.

2. The Examiner has rejected claims 1 to 16, 19 and 20 as presently pending as being unpatentable over Rekhter (US5917820) in view of newly cited reference Wong (US6073178). The Examiner will be aware that in *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531

(Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

3. Rekhter describes an improved arrangement for quickly and efficiently forwarding packets in a packet-switched network (see abstract, for example). Thus, Rekhter is not concerned with allocating unique IP addresses as destination addresses for contacting nodes in an integrated IS-IS communications network but with setting up forwarding tables in routers of a packet-switched network so that packets (such as IP packets) may be forwarded onto the next hop towards their ultimate destination which typically is an end node in the network, not an IS-IS (i.e. intermediate) node. In other words, Rekhter is concerned with forwarding packets whereas the present invention is concerned with allocating unique IP addresses to IS-IS nodes.

4. Wong describes a network of client systems including a router to monitor the assignment of IP addresses to said client systems by a DHCP server. As each IP address is assigned, the router associates the assigned IP address with a trusted identifier which identifies the client system. Subsequently, if the router receives a packet directed at the assigned IP address, the router forwards the packet to the client system having the trusted identifier associated with the destination address of the IP packet. Additionally, if the router receives a packet from a client system, it uses the trusted identifier of the client system to find IP addresses associated with the client system. If the source address of the IP packet is not included in the IP addresses associated with the client system, then the packet is discarded.

5. It is clear from sections 3 and 4 of this submission that Rekhter and Wong, when combined, do not teach or suggest all of the limitations of claim 1, for example, in that neither discloses an IS-IS communications network nor the step of sending information about the selected IP address to nodes in the IS-IS communications network. Nor do either of Rekhter or Wong teach or suggest allocating a unique IP address to a node since, it is clear from the disclosure of Wong, that a client system can have more than one IP address associated with it through its trusted identifier (see abstract and claims of Wong). For this reason alone, the Examiner's rejection of claims 1 to 16, 19 and 20 under 35 U.S.C. 103(a) cannot be sustained.

6. Additionally, one of ordinary skill in the art would not seriously contemplate combining the teachings of Rekhter and Wong since Rekhter relates to setting up forwarding tables in routers of a packet-switched network so that packets (such as IP packets) may be forwarded onto the next hop towards their ultimate destination which typically is an end node in the network whereas Wong is concerned with associating trusted identifiers with IP addresses allocated to client systems by a DHCP server. These references address entirely different technical issues.

7. Even if one of ordinary skill in the art did contemplate combining the teachings of Rekhter and Wong, he/she would then have to go the further step of applying such combined teachings to an IS-IS communications network in order to arrive at the arrangement of the present invention. Thus, it is clear that the Examiner's rejection of the claims requires the person of ordinary skill to do more than combine the teachings of Rekhter and Wong. Even if the person of ordinary skilled contemplated this further step, which it should be noted takes the person of ordinary skill into the realm of inventiveness, the resultant system would exhibit the very problem that the present invention seeks to address. Namely, that for a new device to be added to the network of the resultant system and automatically assigned an IP address, it must be added so that it is directly connected to a DHCP server. This is problematic for complex networks such as those which comprise a plurality of directly connected routers or other intermediate systems such as an IS-IS communications network as in the present invention. In such cases, new network elements may need to be

added so that they are indirectly connected to the DHCP server. However, this is not possible without using a DHCP relay server that is directly connected to the new network element. In order to provide an IP address to such a new network element, the DHCP relay server is used, in addition to the DHCP server itself. The DHCP relay is connected directly to the new network element. This is obviously complex and requires DHCP relay servers to be provided in addition to the DHCP server. The present invention overcomes this problem and thus cannot be considered as being obvious over the combination of Rekhter and Wong.

8. It has been demonstrated in sections 3 to 7 of this submission that the present rejection of claims 1 to 16, 19 and 20 under 35 U.S.C. 103(a) does not satisfy any of the three tests necessary to establish a prima facie case of obviousness. Since the initial burden of establishing a prima facie basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office and, if the Patent and Trademark Office does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of a patent. Accordingly, this application should now be allowed.

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Respectfully submitted,

William M. Lee, Jr.
Registration No. 26,935
Barnes & Thornburg LLP
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 214-4800
(312) 759-5646 (fax)

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